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REMARKS

The Examiner has rejected Claims 1-26 under 35 U.S.C. 103(a) as being unpatentable over Aronson et al. (U.S. Patent No. 6,654,787) in view of Leeds (U.S. Patent No. 6,393,465). Applicant respectfully disagrees with such rejection, especially in view of the amendments made hereinabove to each of the independent claims. Specifically, applicant has incorporated the subject matter of Claim 9 into teach of the independent claims.

With respect to each of the independent claims, the Examiner has relied on the Abstract; Col. 3, lines 54-67; Col. 4, lines 1-23 and 60-67; Col. 5, lines 1-44; and Col. 6, lines 52-65 in Leeds to make a prior art showing of applicant's claimed "identifying an authority hosting the network address" (see the same or similar, but not necessarily identical language in each of the independent claims).

Applicant respectfully asserts that the excerpts relied on by the Examiner only relate to a host computer associated with a sender of an electronic mail message (see Abstract and Col. 4, lines 66-67, specifically). Clearly, determining a host computer/host name of a sender of e-mail does not meet applicant's specific claim language, namely an "authority hosting the network address" (emphasis added).

Still with respect to each of the independent claims, the Examiner has again relied on the Abstract; Col. 3, lines 54-67; Col. 4, lines 1-23 and 60-67; Col. 5, lines 1-44; and Col. 6, lines 52-65 in Leeds to make a prior art showing of applicant's claimed "generating a report containing the identified network address and hosting authority" (see the same or similar, but not necessarily identical language in each of the independent claims).

Applicant respectfully asserts that the only suggestion of a "report" in the excerpts relied on by the Examiner merely relate to reporting e-mail messages as spam to an authentication server (see, specifically, Col. 6, lines 59-63 in Leeds). However, applicant

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notes that such report only consists of the receipt of the spam, by "put[ting] the term 'spam' in the subject of the e-mail message and send[ing] it to the authentication server." Thus, Leeds only discloses forwarding the e-mail itself, and not "generating a report containing the identified network address and hosting authority," as claimed by applicant (emphasis added).

To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art and not based on applicant's disclosure. *In re Vaeck,* 947 F.2d 488, 20 USPQ2d 1438 (Fed.Cir.1991).

Applicant respectfully asserts that at least the third element of the *prima facie* case of obviousness has not been met, since the prior art references, when combined, fail to teach or suggest all of the claim limitations, as noted above. Nevertheless, despite such paramount deficiencies and in the spirit of expediting the prosecution of the present application, applicant has substantially incorporated the subject matter of Claim 9 into each of the independent claims.

With respect to the subject matter of former Claim 9, the Examiner has relied on Col. 3, lines 54-67; Col. 4, lines 1-23; Col. 4, lines 60-67; and Col. 5, lines 1-44 in Leeds to make a prior art showing of applicant's claimed technique "wherein identifying the hosting authority comprises identifying an owner of a network domain." Applicant respectfully asserts that the only host disclosed in Leeds relates to a host computer/host name of a sender of an e-mail (see arguments above with respect to each of the independent claims). Simply nowhere does Leeds even suggest any sort of hosting owner

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of a network domain, let alone where "identifying the hosting authority comprises identifying an <u>owner of a network domain</u>," as claimed by applicant (emphasis added).

Again, since at least the third element of the *prima facie* case of obviousness has not been met, a notice of allowance or a <u>proper</u> prior art showing of <u>all</u> of the claim limitations, in the context of the remaining elements, is respectfully requested.

Applicant further notes that the prior art is also deficient with respect to the dependent claims. Just by way of example, with respect to Claim 2 et al., the Examiner has relied on Col. 4, lines 36-67; Col. 5, lines 1-44; and Col. 8, lines 34-57 in Leeds to make a prior art showing of applicant's claimed "transmitting the generated report to the identified hosting authority." Applicant respectfully asserts that the only mention of any sort of report in such excerpts from Leeds simply teaches that "addresses could be watched for incoming junk e-mail and a notification from the authentication server could then be broadcast to users indicating that mail with the subject of "XYZ" is junk e-mail" (see, specifically, Col. 8, lines 47-50). Clearly, such notification sent to <u>users</u> does not meet applicant's claimed "transmitting the generated report <u>to the identified hosting authority</u>" (emphasis added).

With respect to Claim 4, the Examiner has relied on Col. 4, lines 57-67; Col. 5, lines 1-8; and Col. 5, lines 50-67 in Aronson to make a prior art showing of applicant's claimed technique "wherein identifying a URL comprises comparing text within the electronic message to a database of words to identify the URL." After careful review of the excerpts relied on by the Examiner, applicant notes that the only URL disclosed in Aronson relates to filtering e-mail based on "feature extraction & analysis (e.g.,...URL's...)" (see Col. 5, lines 63-64). However, Aronson does not teach how such URL is identified, whereas applicant specifically claims "identifying a URL [by] comparing text within the electronic message to a database of words to identify the URL." Applicant further notes that Aronson only teaches that spam may be filtered "based on a specific keyword search," and that therefore the keywords are used to

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identify spam, but not that a database of words is utilized to "identify the URL" in the manner claimed by applicant (emphasis added).

With respect to Claim 12, the Examiner has relied on Col. 5, lines 38-44 in Leeds to make a prior art showing of applicant's claimed technique including "at least temporarily saving the report and transmitting the report to the identified hosting authority at the end of a specified period." Applicant respectfully asserts that such excerpt only relates to "sending a verification address…within a period of time." Clearly, sending a verification message to determine if a user is actually associated with the sender of e-mail does not meet applicant's claimed report, let alone "transmitting the report to the identified hosting authority at the end of a specified period" (emphasis added).

Yet again, since at least the third element of the *prima facie* case of obviousness has not been met, a notice of allowance or a proper prior art showing of all of the claim limitations, in the context of the remaining elements, is respectfully requested.

Still yet, applicant brings to the Examiner's attention the subject matter of new Claims 27-31 below, which are added for full consideration:

"wherein identifying the hosting authority further comprises identifying an address, an administrative contact name, an administrative contact telephone number, and a name of at least one server associated with the hosting authority" (see Claim 27);

"wherein identifying the hosting authority further comprises identifying an organization to which the network domain is registered" (see Claim 28);

"wherein the report is utilized to generate an electronic mail message to be sent to the identified organization" (see Claim 29);

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"wherein identifying the URL further comprises examining text surrounding the URL to determine a likelihood that the URL is an address of a web site associated with unsolicited messages" (see Claim 30); and

"wherein the report includes disclaimer information and user definable text" (see Claim 31).

Thus, all of the independent claims are deemed allowable. Moreover, the remaining dependent claims are further deemed allowable, in view of their dependence on such independent claims.

In the event a telephone conversation would expedite the prosecution of this application, the Examiner may reach the undersigned at (408) 505-5100. The Commissioner is authorized to charge any additional fees or credit any overpayment to Deposit Account No. 50-1351 (Order No. NAI1P314/01.166.01).

Respectfully submitted,
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